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60,469-054
OT-4986REMARKS

Applicant respectfully traverses the rejection of claims 1, 3-4, 9, 15-16, 20, 24, 28-37, 40 and 42 which is based upon the proposed combination of WO 01/14630 and *Kilborn, et al.* under 35 U.S.C. §103. The proposed combination cannot be made and there is no *prima facie* case of obviousness. As Applicant explained in the Appeal Brief that resulted in reopening prosecution, the combination cannot be made for several reasons. First, the *Kilborn, et al.* technique cannot be used to make a belt as shown in the WO 01/14630 reference. Applicant incorporates the comments of the Appeal Brief into this response rather than reiterating all of the arguments already made.

Additionally, even if the combination could somehow justifiably be made without violating the limitations on combining references when attempting to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the result of the proposed combination is not consistent with Applicant's claims. As explained in Applicant's Appeal Brief, the *Kilborn, et al.* reference does not teach a technique for realizing a generally smooth, uninterrupted surface on an exterior of the jacket and does not teach maintaining tension on individual cords on an individual basis while applying a jacket material. Therefore, the proposed combination does not result in the claimed invention and there is no *prima facie* case of obviousness against any of the claims rejected on the basis of the proposed combination of WO 01/14630 and the *Kilborn, et al.* reference.

Applicant respectfully traverses the rejection of claim 2 under 35 U.S.C. §103 based upon the proposed combination of WO 01/14630, *Kilborn, et al.* and *Nassimbene*. As already explained in the recent Appeal Brief, the proposed combination of these three references cannot be made for several reasons. One is that the WO 01/14630 and *Kilborn, et al.* references cannot be combined. Another is that the *Kilborn, et al.* reference requires maintaining the same tension on every cord (Col. 1, lines 36-38 and 60). The Examiner proposes to add *Nassimbene* to add different tensions

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on the cords. This is not possible because it is directly contrary to the teachings of *Kilborn, et al.* Such a modification of a reference cannot be made. That would render *Kilborn, et al.* unable to perform its intended function and such a modification is not permitted according to MPEP 2143.01 (V) and (VI). Additionally, the different lengths and tensions used in the *Nassimbene* reference are associated with a V-shaped arched belt. Neither of the WO 01/14630 or *Kilborn, et al.* references include such a belt and, therefore, the *Nassimbene* teachings have no applicability in the context of either of those references. The proposed combination cannot be made and there is no *prima facie* case of obviousness.

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. §103 as being unpatentable over the proposed combination of WO 01/14630, *Kilborn, et al.* and *Tsai*. Applicant has already explained that the *Tsai* reference cannot be added to the improper proposed combination of WO 01/14630. The *Tsai* reference is from an unrelated art and is not properly combinable with the other two references. Additionally, the proposed combination goes directly contrary to the teachings of the other two references, both of which require a flat surfaced configuration while the *Tsai* reference provides a non-flattened configuration as shown in that reference. The proposed combination cannot be made and there is no *prima facie* case or obviousness.

Applicant expressly traverses every conclusion drawn by the Examiner where the Examiner says "it is apparent" or that something is "inherently" included in one of the references or a proposed combination of them. The Examiner will have to provide some further explanation for how such things are "apparently" or "inherently" found in each such reference or the combination of them. It is not enough to merely make a conclusory statement without some explanation for how the determination is justifiable or consistent with a reasonable interpretation of the reference.

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The rejections of claims 5-7, 14, 17-18, 21-23, 26-27, 35, 39 and 41 under 35 U.S.C. §103 that rely upon the *O'Donnell, et al.* reference as part of the proposed combination must be withdrawn. The *O'Donnell, et al.* reference would qualify as prior art, at best, under 35 U.S.C. §102(e). Pursuant to 35 U.S.C. §103(c), the *O'Donnell, et al.* reference cannot be used in a proposed combination against Applicant's claims because the subject matter of the *O'Donnell, et al.* reference and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. This application and the *O'Donnell, et al.* reference are both owned by Otis Elevator Company.


Therefore, all rejections that rely upon the *O'Donnell, et al.* reference as one of the references in a proposed combination under 35 U.S.C. §103 must be withdrawn because none of those proposed combinations can be made.

All claims are allowable. Applicant respectfully requests a Notice of Allowance as early as possible.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

October 2, 2007
Date

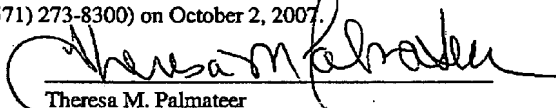


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CERTIFICATE OF FACSIMILE

I hereby certify that this Response, relative to Application Serial No. 10/010,937, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on October 2, 2007.


Theresa M. Palmateer

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